

Docket No. 1670.1015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Yun Soo CHOE et al.

Serial No. 10/652,493

Group Art Unit: 3742

Confirmation No. 2730

Filed: September 2, 2003

Examiner: Sang Yeop Paik

For: HEATING CRUCIBLE FOR ORGANIC THIN FILM FORMING APPARATUS

PETITION UNDER 37 CFR 1.181(a) FOR DESIGNATION OF GROUND OF REJECTION IN EXAMINER'S ANSWER AS NEW GROUND OF REJECTION

Mail Stop Appeal Brief—Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This petition is being filed pursuant to 37 CFR 1.181(a) and MPEP 1207.03(IV) to request that a ground of rejection in the Examiner's Answer mailed July 24, 2007, and having a period for response set to expire on September 24, 2007, pursuant to 37 CFR 41.41(a)(1) be designated as a new ground of rejection.

On page 3 of the Examiner's Answer of July 24, 2007, the Examiner has cited three new references, i.e., Colombo et al. (Colombo) (U.S. Patent No. 6,030,458), Yamashita et al. (Yamashita) (U.S. Patent No. 5,034,200), and Hüther et al. (Hüther) (U.S. Patent No. 4,511,612).

On pages 7 and 8 of the Examiner's Answer of July 24, 2007, the Examiner states as follows:

Note: The Colombo, Yamashita and Huther references are not applied in the ground of rejection, but they are listed under the section (8) Evidence Relied upon above in response to the applicant's newly raised argument in the brief that the pyrolytic boron nitride material shown in Chow is not a heat-resistant material. Contrary to the applicant's argument, these references show that the pyrolytic boron nitride materials are heat-resistant material.

On page 9 of the Examiner's Answer of July 24, 2007, in response to arguments presented on pages 13-15 of the Appeal Brief of April 19, 2007, addressing the rejection of claims 1, 2, 4, 7, 9, 11-13, 16-18, 21-25, and 29-31 under 35 USC 103(a) as being unpatentable over Chow (U.S. Patent No. 5,157,240) in view of Chandler (U.S. Patent No. 2,799,764) or Isaacson et al. (Isaacson) (U.S. Patent No. 3,842,241), the Examiner states as follows:

The applicant further raises a new argument that it is known in the art that the protective layer of Chow which made of pyrolytic boron nitride is a material of a very high thermal conductivity and, as such, the pyrolytic boron nitride transmits heat rather than blocks it. However, contrary to the applicant's argument, it is known in the art that the pyrolytic boron nitride material is a high temperature/heat resistant material as shown in US Patent Nos. 5,034,200 (see column 7, lines 9-14), 6,030,458 (see column 2, lines 15-18), and 4,511,612 (see column 3, lines 13-25). Thus, the applicant's argument is not deemed persuasive.

MPEP 1207.03 provides the following guidelines on MPEP page 1200-35:

37 CFR 41.39(a)(2) permits the entry of a new ground of rejection in an examiner's answer mailed on or after September 13, 2004. New grounds of rejection in an examiner's answer are envisioned to be rare, rather than a routine occurrence. For example, where appellant made a new argument for the first time in the appeal brief, the examiner may include a new ground of rejection in an examiner's answer to address the newly presented argument by adding a secondary reference from the prior art on the record. New grounds of rejection are not limited to only a rejection made in response to an argument presented for the first time in an appeal brief. At the time of preparing the answer to an appeal brief, the examiner may decide that he or she should apply a new ground of rejection against some or all of the appealed claims. In such an instance where a new ground of rejection is necessary, the examiner should either reopen prosecution or set forth the new ground of rejection in the answer.

MPEP 1207.03(III) provides the following guidelines on MPEP page 1200-37:

A new prior art reference applied or cited for the first time in an examiner's answer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the

statement of rejection. *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970).

It is submitted that the Examiner's reliance on Colombo, Yamashita, and Hüther to support the rejection of claims 1, 2, 4, 7, 9, 11-13, 16-18, 21-25, and 29-31 under 35 USC 103(a) as being unpatentable over Chow in view of Chandler or Isaacson clearly constitutes a new ground of rejection under the above guidelines set forth in MPEP 1207.03 and 1207.03(III). Accordingly, pursuant to 37 CFR 1.181(a) and MPEP 1207.03(IV), it is respectfully petitioned that the Examiner be required to issue a corrected Examiner's Answer that identifies the rejection as a new ground of rejection and includes the approval of the Technology Center 3700 Director or designee.

If there are any additional fees associated with the filing of this paper, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

Date: 09/18/07

By: Randall S. Sviha
Randall S. Sviha
Registration No. 56,273

1400 Eye Street, NW
Suite 300
Washington, DC 20005
Telephone: (202) 216-9505
Facsimile: (202) 216-9510